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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,205	09/21/2001	Werner Schulz	1175/65880	6448
7590	04/30/2004		EXAMINER	
Donald S Dowden Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036				PASCUA, JES F
		ART UNIT	PAPER NUMBER	3727

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/937,205	SCHULZ, WERNER
	Examiner Jes F. Pascua	Art Unit 3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 February 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 and 3-10 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1 and 3-10 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 21 September 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "adjacent side wall (2) is folded down onto itself for abutment inner face to inner face" (claim 10) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Although Fig. 6 shows the top wall (3) folded down onto itself for abutment inner face to inner face as claimed, Fig. 8 shows the side wall (2) folded down onto itself for abutment outer face to outer face.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to provide antecedence for the embodiment wherein the "adjacent side wall (2) is folded down onto itself for abutment inner face to inner face". This is a new matter rejection. Although page 11 of applicant's specification and Fig. 8 provide antecedence for the side wall (2) folded down onto itself for abutment outer face to outer face, the

Examiner maintains that there is no antecedence for the side wall (2) folded down onto itself for abutment inner face to inner face.

4. Claims 1 and 3-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to provide antecedence for transverse bottom seams in a bag formed of a single film. This is a new matter rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (see Fig. 3) in view of Heintz et al.

Watanabe discloses the claimed invention except for the walls being separate films sealed together. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the walls of the Watanabe bag from separate films, since it has been held that constructing a formerly integral structure in

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various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Furthermore, making the top and bottom walls of Watanabe from separate films of material would inherently result in the top and bottom walls being sealed to the side wall along transverse seams.

Watanabe discloses the claimed invention except for a heat-sealed peelable connection between the top and side wall. Heintz et al. teaches that it is known in the art to provide a heat-seal, peelable connection adjacent analogous male and female fasteners. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the male and female fasteners of Watanabe with the heat-sealed peelable connection Heintz et al., in order to hermetically seal the bag.

7. Claims 1, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (see Fig. 3) in view of Gotoh et al.

Watanabe discloses the claimed invention except for the walls being separate films sealed together. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the walls of the Watanabe bag from separate films, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Furthermore, making the top and bottom walls of Watanabe from separate films of material would inherently result in the top and bottom walls being sealed to the side wall along transverse seams.

Watanabe discloses the claimed invention except for a heat-sealed peelable connection between the top and side wall. Gotoh et al. teaches that it is known in the art to provide a heat-seal, peelable connection adjacent analogous male and female fasteners. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the male and female fasteners of Watanabe with the heat-sealed peelable connection of Gotoh et al., in order to hermetically seal the bag.

8. Claims 1, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohdin '109.

Rohdin '109 discloses the claimed invention; especially the upper edge portion 18 of the top wall 14 and the upper edge portion 16 of the side wall being heat-sealed together. See Figs. 6-6b. However, it is unclear if the heat-sealed connection is peelable. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the heat-sealed connection between the upper edge portions of the top and side walls of Rohdin '109 a peelable connection, since it was known in the bag art that heat-sealed peelable connections permit relatively easy access to the bag interior and its contents without destroying the structural integrity of the bag.

Rohdin '109 discloses the claimed invention except for the top and bottom walls being separate films sealed to the side walls. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the top and bottom

walls of the Rohdin '109 bag from separate films, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.. Furthermore, making the top and bottom walls of Rohdin '109 from separate films of material would inherently result in the top and bottom walls being sealed to the side wall along transverse seams.

Allowable Subject Matter

9. Claim 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments

10. Applicant's arguments filed 02/26/04 on have been fully considered but they are not persuasive.

Applicant's arguments, filed 02/26/04, regarding the drawing objection have been fully considered but they are not persuasive for the reason set forth above.

Applicant's arguments, filed 02/26/04, regarding the new matter rejection of claim 10 have been fully considered but they are not persuasive for the reason set forth above.

Applicant's argument that Watanabe does not show transverse bottom seams is not persuasive because the Examiner's rejection never stated that Watanabe had transverse bottom seams. The rejection states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the walls of

the Watanabe bag from separate films and by making the top and bottom walls of Watanabe from separate films of material would inherently result in the top and bottom walls being sealed to the side wall along transverse seams. Applicant's remarks are silent on this issue.

Regarding applicant's remark that Watanabe does not show the inwardly folded top and bottom walls being sealed outer face to outer along top and bottom side seams, the respective outer faces of Watanabe's inwardly folded top and bottom walls are sealed to each other along side seams formed through exposing ports 9, 9 and 8, 8 as shown in Figs. 2 and 3.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Heintz et al. teaches that it is known in the bag art to provide a heat-seal, peelable connection adjacent analogous male and female fasteners for the purpose of hermetically sealing the bag.

In response to applicant's arguments that the combination of Watanabe and Heintz et al., Gotoh et al. or Rohdin do not amount to the claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily

incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant's argument that Rohdin does not show transverse bottom seams is not persuasive because the Examiner's rejection never stated that Watanabe had transverse bottom seams. The rejection states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the walls of the Rohdin bag from separate films and by making the top and bottom walls of Rohdin from separate films of material would inherently result in the top and bottom walls being sealed to the side wall along transverse seams. Applicant's remarks are silent on this issue.

In response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument based upon the age of the Rohdin reference, contentions that the reference patents are old are not impressive absent a showing that

the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 703-308-1153. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jes F. Pascua
Primary Examiner
Art Unit 3727

JFP